

NOV 30 2009

PTO/SB/33 (07-05)  
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U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>  Mail Stop AF	<b>Application Number</b>	10/782,530
	<b>Filing Date</b>	January 23, 2004
	<b>First Named Inventor</b>	Minoru SANO
	<b>Group Art Unit</b>	3763
	<b>Examiner Name</b>	Nathan R. Price
	<b>Attorney Docket No.</b>	NPR-135

Applicant(s) request(s) review of the final rejection in the above-identified application. No amendments are being filed with this request.

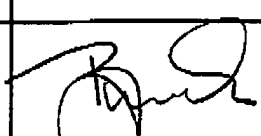
This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).  
Note: No more than five (5) pages may be provided.

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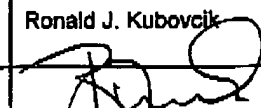
- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.
- ☒ attorney of agent of record.
- ☐ attorney of agent acting under 37 CFR 1.34.

**SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT REQUIRED**

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<b>Signature</b>	
<b>Date</b>	November 30, 2009

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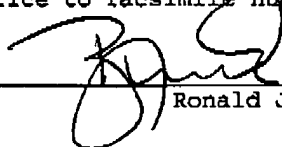
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 10/762,530 Confirmation No. 5543  
Applicant : Minoru SANO et al.  
Filed : January 23, 2004  
TC/A.U. : 3763  
Examiner : Nathan R. Price  
Dkt. No. : NPR-135  
Cust. No. : 20374

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\_\_\_\_\_  
Ronald J. Kubovcik

REMARKS ACCOMPANYING  
PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

November 30, 2009

Sir:

This paper includes remarks in support of a Pre-appeal Brief Request for Review. A Notice of Appeal is being filed concurrently herewith.

This is an appeal from the decision dated May 28, 2009, of the Primary Examiner finally rejecting claims 1 and 3 in this application.

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Claims 1 and 3 of the present application recite a prefilled syringe. The prefilled syringe of the invention comprises, as an element thereof, a shoulder portion provided with a luer tip arranged to be connected to an injection needle at a tip thereof.

Claims 1 and 3 are rejected in the Final Action under 35 U.S.C. 103(a) as being unpatentable over Reinhard et al., U.S. Patent No. 6,331,174 ("Reinhard") in view of Kaufhold, Jr. et al., U.S. Patent No. 5,125,898 ("Kaufhold").

The Examiner admits that the syringe of Reinhard does not include a luer tip, but asserts that it would have been obvious to modify the syringe of Reinhard such that it comprises a luer tip, as taught by Kaufhold.

The proposed modification of the syringe of Reinhard to include a luer tip is improper as a matter of law.

The invention of Reinhard is a prefilled, disposable syringe that overcomes the problems and disadvantages of disposable syringes of the prior art. One of the prior art disposable syringes identified in Reinhard is that disclosed in U.S. Patent No. 4,861,335. The disposable syringe disclosed in U.S. Patent No. 4,861,335 includes a luer tip. (Note the description of the prior art syringe in Col. 2, lines 17-19, of Reinhard: "The hypodermic

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needle is fastened to the cap by means of a mounting method known under the brand name LUER-LOCK. Therefore, the needle is not integrated with the nozzle.").

In light of the prior art described therein, Reinhard discloses as the object of its invention, to provide a prefilled syringe that can be manufactured as a preassembled unit "consisting of a barrel with an integrated needle ...". (Col. 2, lines 42-43). I.e., the invention of Reinhard is a prefilled syringe consisting of a barrel with an integrated needle. The nozzle area of the disposable syringe of Reinhard is especially constructed to encase the needle. See, for example, Col. 3, lines 31-37:

"One development of the disposable syringe in this invention lies in the nozzle area where the hypodermic needle is fastened. The nozzle is constructed to encase the needle, which has an advantage over known finished glass syringes with a glued-in needle, so that no adhesive can interact with the preparation. This is especially important for highly sensitive preparations."

The proposed modification of the prefilled syringe of Reinhard to include a needle not integrated with the nozzle will destroy the invention on which Reinhard is based.

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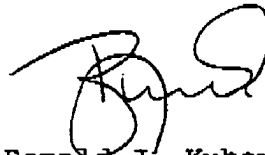
It has been established by the Office that references cannot be properly combined if the effect would destroy the invention on which one of the references is based. (See *Ex parte Hartmann*, 186 USPQ 366 (BdPatApp&Int 1974)).

For this reason, the final rejection of the Primary Examiner is based on an error of law and should be reversed.

Please charge any required fees or credit any overpayment to our Deposit Account No. 111833.

Respectfully submitted,

KUBOVCIK & KUBOVCIK



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